

REMARKS

Reconsideration of this application, as amended, is respectfully requested.

Initially, the Applicants would like to thank the Examiner for the courtesy and assistance extended during the personal interview conducted on February 11, 2008, with Thomas Spinelli.

As another initial matter, Applicants would also like to thank the Examiner for continuing to maintain the allowability of claim 21 if the same were amended into independent form.

In the Official Action, the Examiner rejects claims 1, 15, 16, 18-20 and 22 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,982,725 to Hibino et al., (hereinafter “Hibino”). Additionally, the Examiner rejects claims 8, 9, 23 and 24 under 35 U.S.C. § 103(a) as being unpatentable over Hibino in view of U.S. Patent No. 5,609,563 to Suzuki et al., (hereinafter “Suzuki”).

In response, Applicants respectfully traverse the Examiner’s rejections under 35 U.S.C. §§ 102(b) and 103(a) for at least the reasons set forth below.

In Official Action, the Examiner continues to argue that Hibino teaches the second unit 503 being removably connected to the first unit (citing column 46, lines 48-52 of Hibino). Applicants respectfully disagree.

Specifically, the Examiner argues that Hibino teaches the second unit 503 is removably connected to the first unit at column 46, lines 48-52. Applicants respectfully submit that the Examiner is confused by errors in Hibino and has misinterpreted the same due to such errors. Specifically, Hibino uses reference numeral 503 in the Figures to denote three different features (Figures 12, 16 and 18 all use reference numeral 503). Therefore, the

portion of the specification cited by the Examiner at column 46, lines 48-52 refers to the reference numeral 503 that is illustrated in Figure 12 (that is, the video-processor is removably connected to the connector 503 as shown in Figure 12). The Examiner mistakenly feels that the cited portion of column 46, lines 48-52 refers to the connector 503 that is shown in Figure 18. Applicants submit that the first portion of the paragraph starting at column 46, line 46 refers to the connector 503 shown in Figure 18 that is connected to the insertion part 504 of the endoscope. However, the second portion of the paragraph starting at column 46, line 46 refers to the connector 503 shown in Figure 12 that is removably connected to the video processor. Therefore, Hibino does not disclose or suggest the second unit being removably connected to the first unit. As further proof, Hibino does not disclose or suggest any structure for connecting and disconnected any of the components housed in portion 503 with the proximal end of the insertion portion 504 (e.g., bending wires 510).

During the personal interview, the Examiner indicated agreement with Applicants arguments that the first and second units of Hibino were not separable due to the errors in Hibino and lack of description or enablement with regard to such units being separable.

The Examiner also continues to assert that the relay cord (665) shown in Figure 16 can be considered as the buffering member that has a first end connected to the frame unit of the first unit (663) and a second end connected to the main frame of the second unit (503) so that a force applied to the inserting portion is absorbed between the first and second end (see the bottom of page 5 to the top of page 6 of the Official Action). Applicants submit that the connector (503) in Figure 16 is connected to a universal cord and not the insertion portion (504), thus, the relay cord (665) could not absorb a force applied to the

inserting portion (504). Thus, the relay cord (665) shown in Figure 16 of Hibino is not for absorbing any external force applied to the insertion portion but merely for connecting the connector (503) mounted to the bending controlling apparatus (663) and the light source apparatus (661).

Still further, Applicants respectfully submit that Hibino does not disclose a buffering member having the features recited in claims 1 and 18. The motor shown in Figure 16 is not arranged in the bending controlling apparatus (663) but in the endoscope (501). Thus, the bending controlling apparatus could not correspond to the first unit recited in the claims. Even if there were a motor in the endoscope (501) illustrated in Figure 16 of Hibino and the thick operating part (505) could be considered the first unit, Hibino simply does not disclose or suggest a buffering unit having the features recited in independent claims 1 and 18. With regard to Figure 18 of Hibino, even if the connector (503) and the bending controlling apparatus (663) were separable (which they are not), the same simply does not illustrate or disclose a buffering member having the features recited in independent claims 1 and 18.

With regard to the rejection of claims 1, 15, 16, 18-20 and 22 under 35 U.S.C. § 102(b), an electric bending endoscope having the features discussed above and as recited in independent claims 1 and 18, is nowhere disclosed in Hibino. Since it has been decided that “anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim,”¹ independent claims 1 and 18 are not anticipated by Hibino. Accordingly, independent claims 1 and 18 patentably distinguish

¹ Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).

over Hibino and are allowable. Claims 15, 16 19, 20 and 22 being dependent upon claims 1 and 18, are thus at least allowable therewith.

With regard to the rejection of claims 8, 9, 23 and 24 under 35 U.S.C. § 103(a), since independent claims 1 and 18 patentably distinguish over the prior art and are allowable, claims 8, 9, 23 and 24 are at least allowable therewith because they depend from an allowable base claim.

Furthermore, new claims 25-28 have been added to further define the patentable invention. New claims 25-28 are fully supported in the original disclosure. Thus, no new matter has been entered into the disclosure by way of the addition of new claims 25-28.

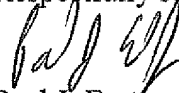
New independent claims 25 and 27 are similar to claims 1 and 18 except that they clearly recite the main frame and frame unit as being separable. As discussed above, the Examiner has now indicated during the personal interview that Hibino does not disclose such features.

New independent claims 26 and 28 are similar to claims 1 and 18 except that they no longer recite the buffering member and instead recite a gear unit that is separable from the motor unit of the frame unit such that the gear unit can be replaced without replacing the motor unit (and vice versa). The Examiner also indicated during the personal interview that Hibino does not disclose such features.

Applicants respectfully submit that new independent claims 25-28 patentably distinguish over the prior art and are allowable for at least the above reasons.

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicants' attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,



Paul J. Esatto, Jr.

Registration No.: 30,749

Scully, Scott, Murphy & Presser, P.C.
400 Garden City Plaza, Suite 300
Garden City, New York 11530
(516) 742-4343
TS:cm